

REMARKS

The above amendments and these remarks are responsive to the Office action dated May 16, 2005. Claims 1-31 are pending in the application. In the Office action, the Examiner rejected claims 1-5 and 31 as being anticipated by Anderson (U.S. 4,999,593). The Examiner objected to claims 6-8 as being dependent upon a rejected base claim, but said they would be allowable if rewritten in independent form. Claims 9-30 were allowed. The applicant thanks the Examiner for allowing claims 9-30 and indicating the allowability of claims 6-8. In view of the remarks below, claims 6-8 are not being amended. The applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

Rejections under 35 USC § 102

Claims 1 and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Anderson. Claim 1 recites "first and second conductive lines having at least first and second coupled sections of unequal length, and an uncoupled section between the first and second coupled sections." With respect to claim 1, the Office action states, "Anderson discloses a coupler comprising: first (202) and second (204) conductive lines having at least first (L1) and second (L2) coupled sections of unequal length, and an uncoupled section (210) between the first and second coupled sections." Page 2. The applicant respectfully traverses this rejection.

Anderson does not show or teach first and second coupled sections of unequal length. Fig. 2 of Anderson shows a coupler with a primary transmission line

and a secondary transmission line. "The secondary transmission line comprises a first line segment 206, a second line segment 208, and a phase-shifting line 210." Column 3, lines 59-61. Instead of showing coupled line segments having unequal lengths, Fig. 2 shows that the lengths of line segments 206 and 208 are exactly the same. Furthermore, the text of Anderson is silent as to the relative lengths of line segments 206 and 208.

In *Dayco Products, Inc. v. Total Containment, Inc.*, the Federal circuit held, "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence[; however, s]uch evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference." 329 F.3d 1358, 1369 (Fed. Cir., 2003), quoting *Cont'l Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). In other words, if a prior art reference is silent with respect to a characteristic recited in a claim, the prior art reference only anticipates the claim if the characteristic is necessarily present (i.e., inherent) in the thing described in the reference.

The patent in dispute in *Davco Prods., Inc.* is U.S. Patent No. 5,380,050, which is directed to flexible hoses and coupling assemblies that connect to each other for use in underground gas containment systems. 329 F.3d at 1360. The defendant asserted that the '050 patent was invalid in view of a prior patent to Lusher. *Id.* at 1369. Claim 1 in the '050 patent requires a polymeric hose, and the defendant admitted "that the [Lusher] reference fails to expressly state that the hose of Lusher is a polymeric hose." *Id.* As there was no support on the record for the

proposition that the hose in Lusher was necessarily made of a polymeric material, the Federal Circuit held that “the district court erred in concluding that Lusher teaches each and every limitation of claim 1.” Like the reference in *Davco Prods., Inc.*, Anderson fails to expressly state that line segments 206 and 208 may have unequal lengths. Therefore, Anderson fails to anticipate the subject matter of claim 1 without a showing that line segments 206 and 208 necessarily have unequal lengths.

The applicant notes that “[i]nherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002). The Examiner bears the burden of showing that missing descriptive material is necessarily present. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (emphasis in original) MPEP § 1221 quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In *Ex parte Levy*, the Board noted that “[e]ach of the independent claims on appeal defines a polymeric balloon which is ‘biaxially oriented.’ Ergo, in order to establish a prima facie basis to defeat the patentability of independent claims 13 and 25 under 35 U.S.C. 102, the examiner is obliged to point out where Schjeldahl discloses a biaxially oriented polymeric balloon.” 17 USPQ2d at 1461. The Examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board recognized that, in Schjeldahl's disclosure, “the starting material is a biaxially

oriented synthetic plastic material,” but noted that such a disclosure “do[es] not justify the determination that Schjeldahl discloses a biaxially oriented polymeric balloon.” *Id.* at 1461. “The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.” MPEP §2112.

As Anderson fails to explicitly disclose coupled sections of unequal length, the Examiner must provide support for the proposition that line segments 206 and 208 are necessarily of unequal length to maintain a 35 U.S.C. 102(a) rejection based on Anderson. However, line segments 206 and 208 are shown to have the same length, and therefore could not be shown to necessarily have unequal lengths. The applicant submits that coupler 200 of Anderson functions as described when line segments 206 and 208 are equal in length. Accordingly, Anderson cannot support a rejection of claim 1 under 35 U.S.C. § 102(a).

Accordingly, claim 1 clearly distinguishes over Anderson. Therefore, independent claim 1, as well as claims 2-5 and 31, which depend from claim 1, are allowable for at least the same reasons that claim 1 is allowable. Accordingly, the applicant respectfully requests withdrawal of the rejections based upon 35 U.S.C. 103.

The applicant believes that all of the claims in this application are in condition for allowance, in view of the above amendments and remarks. Accordingly, the applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone

interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on August 15, 2005.



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